

REMARKS

This is in response to the *Non-Final* Office Action, dated November 2, 2004, where the Examiner has rejected claims 28-29, 31-35, 38-39, 41-45. Reconsideration and allowance of pending claims 28-29, 31-35, 38-39, 41-45 in view of the following remarks are respectfully requested.

A. Rejection of Claims 28-30 and 38-39 under 35 U.S.C. § 102(e)

The Examiner has rejected claims 28-30 and 38-39, under 35 U.S.C. § 102(e), as being anticipated by Oshikiri, et al. (USPN 6,470,310) ("Oshikiri"). Applicant respectfully disagrees.

Applicant hereby swears behind the effective filing date of Oshikiri, i.e. September 28, 1999, under 37 C.F.R. § 1.131. Under 37 C.F.R. § 1.131, the inventor of the claimed invention may submit an appropriate declaration to overcome a reference. The showing of facts shall be such as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the effective date of the reference to a subsequent reduction to practice or to the filing of the application. See 37 C.F.R. § 1.131. Applicant respectfully submits that claims 28-29 and 38-39 are allowable over Oshikiri based on the following remarks.

Pursuant to 37 C.F.R. § 1.131, attached is a declaration from inventor Yang Gao, including a copy of an Innovation Disclosure, having Docket No. 98RSS366, which was entered into the Rockwell Semiconductor Systems, Inc. Disclosure Database on September 1, 1998.

The Examiner will note that the last page of the enclosed Innovation Disclosure clearly shows that the Innovation Disclosure was entered into the Rockwell Semiconductor Systems, Inc. Disclosure Database, on September 1, 1998 at 10:48:38 AM, which predates the effective

filing date of Oshikiri, i.e. September 28, 1999. Applicant respectfully submits that the Innovation Disclosure, entitled "Adaptive Excitation Pattern for Low Bit Rate Speech Coding" evidences that the inventor was in possession of the presently claimed subject matter on September 1, 1998. For instance, the Examiner's attention is directed to page 2 of the Innovation Disclosure, under the heading "Solution" and Figure 1.

In response to applicant's previous evidence to swear behind Oshikiri, the Examiner states that the evidence submitted by applicant "does not show reduction to practice since Exhibit A, (entered in the Rockwell Semiconductor Systems, Inc. Disclosure Database on September 1, 1998 proceeded by numerous revisions), only shows the revision history, but fails to show reduction to practice prior to the Oshikiri et al. reference. The examiner notes that it seems that the applicant may have been adding new concepts to the invention due to the numerous revisions." (Office Action, Page 3.) In response to the Examiner's statement, the enclosed declaration reads: "I declare that the contents of sections 1, 4, 5, 6 and 7 of the enclosed Innovation Disclosure were not revised and remained unchanged after the entry date of September 1, 1998, as indicated in the enclosed Innovation Disclosure." (Gao Declaration, ¶ 5.) Applicant respectfully submits that the Revision History can be created by the administrative staff by, for example, changing the Ranking of the Innovation Disclosure. Therefore, the Revision History, as confirmed by the inventor of the present application, does not relate to modifications to the contents of sections 1, 4, 5, 6 and 7.

Furthermore, the Examiner states that the evidence submitted by applicant "is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Oshikiri et al. reference. The applicant did not provide a statement supporting when the application was reduced to practice."

(Office Action, Page 2.) Applicant respectfully disagrees. To this end, the enclosed declaration reads: "I declare that the present invention, as defined by claims 28-29, 31-35, 38-39, 41-45 pending in the above-referenced application, was reduced to practice at Rockwell Semiconductor Systems, Inc. (which changed its name to Conexant Systems, Inc.) in the United States at 4311 Jamboree Road, Newport Beach, California 92660, on or prior to September 1, 1998, using due diligence after conception of invention of the subject matter of the above-referenced application."

(Gao Declaration, ¶ 6.) As stated by the inventor of the present application, the present invention was reduced to practice, in the United States, on or prior to September 1, 1998. The actual reduction to practice is evidenced by the enclosed Innovation Disclosure, which recites $P(n) = C \sum_i G_i \cdot \delta(n - Ti) + \delta(n)$, in support of pending claims 28-29, 31-35, 38-39, 41-45, in addition to further detail of the present invention. The above-recited formula clearly shows that the inventor was in possession of the invention on or prior to September 1, 1998.

Accordingly, applicant respectfully requests that the rejection of claims 28-29 and 38-39, as being anticipated by Oshikiri under 35 U.S.C. § 102(e) be withdrawn.

B. Rejection of Claims 31, 33-35, 41 and 43-45 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 31, 33-35, 41 and 43-45 under 35 U.S.C. § 103(a), as being unpatentable over Oshikiri in view of Akamine, et al. (USPN 5,265,167) ("Akamine"). Applicant respectfully disagrees.

For the reasons stated above, applicant respectfully submits that rejection of claims 31, 33-35, 41 and 43-45 as being unpatentable over Oshikiri in view of Akamine should be withdrawn.

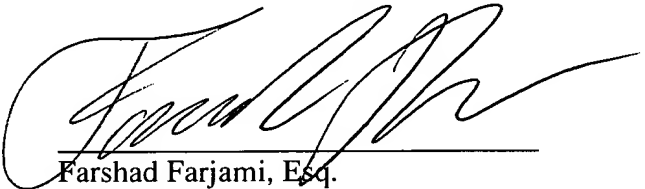
C. Rejection of Claims 32 and 42 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 32 and 42 under 35 U.S.C. § 103(a), as being unpatentable over Oshikiri in view of Akamine, in further view of McDonough, et al. (USPN 5,926,786) ("McDonough"). For the reasons stated above, applicant respectfully submits that rejection of claims 32 and 42 over Oshikiri in view of Akamine and McDonough should be withdrawn.

D. Conclusion

For all the foregoing reasons, an early allowance of claims 28-29, 31-35, 38-39, 41-45 pending in the present application is respectfully requested. The Examiner is invited to contact the undersigned for any questions.

Respectfully Submitted;
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